PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Art Unit: 2137

Kenneth L. Levy   Confirmation No.: 1849

Application No.: 10/622,079

Filed: July 16, 2003   **Via Electronic Filing**

For: Fingerprinting Applications (as previously
        amended)

Examiner: J. Williams

Date: November 18, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

     Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

     This request is being filed with a Notice of Appeal.

     The review is requested for the reasons stated on the attached sheets. No more than 5 pages are provided.

                                        Respectfully submitted,

Date: November 18, 2008

                                        DIGIMARC CORPORATION

          CUSTOMER NUMBER 23735

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In re application of:	Art Unit: 2137
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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Introduction:

On Appeal the rejection of claims 30 and 36-55 will be reversed. Some of the reasons for reversal are discussed below.

Analysis - Art-based Rejections:

Claim 30 in view of Schmelzer and Razdan

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1396 (2007), noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

The final Office Action fails to establish a _prima facie_ case of obviousness for claim 30 since it fails to provide a clear articulation of the reasons why the combination of claim 30 would have been obvious.

For example, claim 30 recites – in combination with other features – maintaining a list of content items, _the list comprising a subset of content items designated as active._

The July 24, 2008 final Office Action (hereafter referred to as the "final Office Action") cites to Schmelzer at paragraphs 6, 7 and 34 to meet these features. See the final Office Action, page 7, lines 1-3. But Schmelzer's paragraphs 6 and 7 merely

provide background on peer-to-peer file sharing systems (e.g., Napster) and the rampant problem of copyright infringement. And while Schmelzer's paragraph 34 does discuss comparing generated fingerprints with an archive of fingerprints for registered copyright works, it does not discuss a list (or archive) including a <u>subset of content items designated as active</u>.

The final Office Action merely states: "[T]he content item within the list are the subset of all copyright works and are designated as 'active' to be monitored." See the final Office action, page 10, lines 17-19. This statement is not helpful in rendering obvious claim 30 for at least two reasons.

First, the final Office Action's characterization overstates Schmelzer's teachings and the reasonable inferences that could be drawn there from. For example, Schmelzer does not <u>designate</u> a subset of the content items represented <u>on</u> the list of content item as "active".

Second, the final Office Action's characterization misinterprets claim 30. Claim 30 requires that a <u>sub</u>set of the maintained list of content items be designated as "active". The final Office Action, instead, would say that the entire maintained list include a "subset" of all possible copyright works. See the final Office Action, page 7, lines 1-3. Indeed, Schmelzer does not designate a <u>sub</u>set of <u>the</u> maintained list of content items as "active," as required by claim 30.

Thus, the final Office Action fails to provide a clear articulation of the reasons why the claimed invention would have been obvious over Schmelzer and Razdan.

The rejection of claim 30 will be reversed on Appeal.

Claim 40 and 45 in view of Schmelzer and Razdan

Claim 40 recites – in combination with other features – identifying a subset of a list of content items as active content items, <u>the subset being associated with those content items being subject to updates</u>.

The final Office Action fails to expressly address these features. Instead, it lumps these features with those of twenty (20) other claims, and then devotes a mere 19 lines to rejecting these twenty claims. See the final Office Action, page 7, line 16 – page 8, line 12. That's less than 1 line per claim. We highly doubt that the Board of Patent Appeals ("Board") will view this as satisfying the clear articulation requirements set forth in <u>KSR</u> and <u>In re Kahn</u>. Indeed, there is no analysis supporting the rejection of claim 40,

including the features of a "*subset being associated with those content items being subject to updates*".

This type of rejection also cuts against the sage advice given in the MPEP. For example: "[T]he examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate…." See MPEP 706.02(j). This is because "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." See MPEP 706.02(j).

Claim 45 (dependent on claim 30) recites that the subset of content items designated as active <u>are associated with database entries to be updated</u>. Here, again, there is no discussion of these features in the final Office Action.

The Board will reverse the rejection of claims 40 and 45 at least since the final Office Action fails to even address "identifying a subset of a list of content items as active content items, *the subset being associated with those content items being subject to updates*" (claim 40) and the subset of content items designated as active *are associated with database entries to be updated* (claim 45).

Claim 36 in view of Schmelzer and Razdan

Claim 36 recites – in combination with other features - receiving a playlist, the playlist identifying content items to be transmitted through the network during a predetermined time period; and based at least in part on the playlist, updating the list of content items by adding at least a plurality of content items and removing at least a plurality of content items, but not all of the content items, from the list.

The final Office Action cites to Schmelzer at paragraphs 67 and 83 to meet these features. See the final Office Action, page 8, lines 1-5. The Board will disagree with this analysis for at least two reasons.

First, the cited Schmelzer passages say nothing of updating the list of content items *<u>based</u> at least in part on a received playlist* (which playlist indicates content items to be transmitted through the network during a predetermined time period). Thus, the final Office Action overstates the teachings in the references. The cited Schmelzer paragraphs 67 and 83 are reproduced below for convenience.

[0067] *Within the transaction database service 344, a database 345 stores all media received by the media analysis system 326. The database 345 is preferably relational to facilitate dimensional reporting, and preferably also permits high volume updates. A transaction recording and management service 343 is provided to manage queries to the database service 344 and also to manage data recordation in the database 345. Preferably, a data enrichment service 347 in communication with the database service 344 is provided to facilitate either automatic or manual addition of information potentially useful to the CPS (such as according to the method provided in FIG. 7).*

[0083] *Each network appliance 602, 614, 606, 608 preferably includes a memory for receiving and storing content-based identifiers, including fingerprints. Preferably, each network appliance 602, 614, 606, 608 includes a processor to provide content type identification and content assessment capabilities. Each network appliance 602, 614, 606, 608 may be periodically updated with new identifiers from the network data center 630, such as identifiers for newly registered copyrighted works. The distributed architecture of a CPS according to FIG. 8 facilitates rapid monitoring of high-bandwidth watched networks 612, 614, 616, 618. Each network appliance 602, 604, 606, 608 may communicate with the network data center 630 by way of a public network such as the Internet, a virtual private network, a dedicated private network, or any combination of such connection types to promote system reliability in case one becomes inoperable. Additionally, while FIG. 8 illustrates only a single network appliance at each watched network 612, 614, 616, 618, redundant network appliances may be provided at each location to enhance overall system reliability.*

Indeed, the above passages say nothing of updating the list of content items *based at least in part on a received playlist* (which playlist indicates content items to be transmitted through the network during a predetermined time period).

Second, the cited passages (paragraphs 67 and 83) say nothing of updating the list of content items by adding at least a plurality of content items and removing at least a plurality of content items. At best, the passages talk about receiving and storing fingerprint identifiers (see paragraph 83). These passages say nothing of adding a plurality of content items (and removing a plurality of content items). Here, again, the final Office Action overstates the teaching of Schmelzer.

Thus, the final Office Action fails to establish a *prima facie* case of obviousness for claim 36 over Schmelzer and Razdan.

The rejection of claim 36 will be reversed on appeal.

Claim 38 in view of Schmelzer and Razdan

Claim 38 recites receiving a list of content items, with each item on the list of content items being associated with one or more fingerprints derived from the respective content item itself; and adding and deleting entries in a table or data structure *according to the list of content items*.

We guess[1] that the final Office Action intended to use Schmelzer's paragraphs 67 and 83 to reject these features of claim 38. See the final Office Action, page 8, lines 1-5.

But paragraphs 67 and 83 – reproduced above – say nothing of adding or deleting entries *according to a received list of content items*.

The rejection of Claim 36 will be reversed on Appeal.

Analysis - Formal Rejections:

The claims are objected to under 35 U.S.C. § 112, first paragraph. See the final Office Action, page 5, lines 18-25. We disagree. Support for the claims can be found throughout the application including, e.g., page 10, line 1 – page 12, line 7; Fig. 1; and Fig. 2.

Conclusion:

We respectfully request that prosecution be reopened and a Notice of Allowance issued. We reserve our right to explore these/additional positions on Appeal, if needed.

	Respectfully submitted,
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[1] Applicants shouldn't have to "guess" how a claim is rejected. The final Office Action rejects 20 claims in a mere 19 lines – less than 1 line per claim. See the final Office Action, page 7, lines 16 – page 8, line 12. Forcing an Applicant to guessing as to how a claim is rejected cuts strongly against established case law (e.g., KSR) and the MPEP (e.g., MPEP 706.02(j)). Indeed, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reasons why the claimed invention would have been obvious. See KSR and In re Kahn.